

## **REMARKS**

Applicant is in receipt of the Office Action mailed October 8, 2003. Claims 77, 121, and 145 were cancelled. Claims 73, 117, and 143 were amended to substantially include the limitations of the cancelled claims. Claim 136 was amended to correct a minor error. Claims 73-76, 78-144, and 146-152 remain pending in the case. Reconsideration of the present case is earnestly requested in light of the following remarks.

### **Section 102 Rejections**

Claims 73-76, 86-87, 117-120, 124, and 143-144 were rejected under 35 U.S.C. 102(a)(e) as being anticipated by Applicant's admitted prior art of figures 4A-4C. Applicant respectfully disagrees.

Amended claim 73 recites:

73. (Currently Amended) A computer-implemented method for navigating among a hierarchy of palette windows in a graphical user interface displayed on a computer system, wherein the computer system includes a display, the method comprising:

displaying on the display a first palette window from the hierarchy of palette windows, wherein one or more of the palette windows in the hierarchy comprise palette items that are selectable by a user to include functionality in a program, and wherein the first palette window includes one or more navigation items displayed on the first palette window for navigating among the hierarchy of palette windows;

receiving user input selecting a navigation item displayed on the first palette window;

closing the first palette window in response to said receiving user input selecting the navigation item; and

displaying at least one of a parent palette window or a child palette window in relation to the first palette window in the hierarchy of palette windows in response to said user input selecting the navigation item.

As the Examiner is certainly aware, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant submits that the prior art of Figures 4A-4C neither teaches nor suggests the limitation “closing the first palette window in response to said receiving user input selecting the navigation item”, and so Applicant respectfully submits that claim 73, and claims dependent thereon, are patentably distinguishable over the prior art of Figure 4A-4C, and are thus allowable for at least this reason. Applicant further submits that since independent claims 117 and 143 contain similar limitations as claim 73, claims 117 and 143, and claims respectively dependent thereon, are patentably distinguishable over the prior art of Figure 4A-4C, and are thus allowable for at least this reason, as well. Removal of the 102 rejections of claims 73-76, 86-87, 117-120, 124, and 143-144 is earnestly requested.

### **Section 103 Rejections**

Claims 77-80, 82-84, 95-101, 103, 104-107, 111-113, 121-122, 128-134, 135-140, 145-146, 149, and 151 were rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant’s admitted prior art (of Figure 4A-4C) and Filepp (U.S. Patent 5,578,072, “Filepp”). Applicant respectfully disagrees. The limitations of cancelled claims 77, 121, and 145 were moved to their respective base claims, and so the 103(a) rejection of claims 77, 121, and 145 are rendered moot. Arguments directed toward these limitations are included below.

As held by the U.S. Court of Appeals for the Federal Circuit in *Ecolchem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the

claimed invention is defective as hindsight analysis. In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular . . . . Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Regarding independent claims 95, 104, 128, 136, 149, and 151, as well as amended independent claims 73, 117, and 143, which substantially include the limitations of cancelled claims 77, 121, and 145, the Office Action asserts that Applicant’s admitted prior art in combination with Filepp produces all the features and limitations of these claims, citing Applicant’s Figures 4A-4C and Figure 3b of Filepp. Applicant respectfully disagrees.

As the Office Action admits, Applicant’s prior art (Figures 4A-4C) does not teach or suggest the limitation “closing the first palette window in response to said receiving user input selecting the navigation item”. Applicant notes that the inclusion of a close icon on a window for (a user) manually closing the window is not the same as the computer-implemented closing of the palette window in response to or subsequent to selection of the navigation item, and so Applicant respectfully submits that this limitation is not taught or suggested by Filepp.

More generally, Applicant submits that neither the Applicant’s prior art nor Filepp teaches or describes a “hierarchy of palette windows, wherein one or more of the palette windows in the hierarchy comprise palette items that are selectable by a user to include functionality in a program, and wherein the first palette window includes one or more navigation items displayed on the first palette window for navigating among the hierarchy of palette windows”.

Applicant further submits that neither the Applicant’s prior art nor Filepp includes a motivation to combine the cited references, and so Applicant respectfully submits that the 103(a) rejection based on these references is improper.

Thus, Applicant respectfully submits that neither Applicant's prior art, nor Filepp, either singly or in combination, teaches or suggests the features and limitations of claims 95, 104, 128, 136, 149, and 151, as well as amended independent claims 73, 117, and 143, and thus claims 95, 104, 128, 136, 149, 151, 73, 117, and 143, and claims respectively dependent thereon, are patentably distinct over the cited references for at least the reasons provided above, and are thus allowable. Removal of the 103 rejection of claims 78-80, 82-84, 95-101, 103, 104-107, 111-113, 122, 128-134, 135-140, 146-146, 149, and 151 is respectfully requested.

Applicant also asserts that numerous ones of the dependent claims recited further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

## CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-43100/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Request for Approval of Drawing Changes
- ☐ Notice of Change of Address
- ☐ Check in the amount of \$            for fees (            ).
- ☐ Other:

Respectfully submitted,



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